

## **REMARKS**

### **Introduction**

With the addition of new claims 57 and 58 herein, claims 29-35, 37-43, 45-51 and 53-58 are currently pending. Claims 31, 33, 35, 37, 40, 42, 45, 48 and 53 have been amended. No new matter has been presented. Reconsideration as to the patentability of the claimed subject matter is requested in view of the foregoing amendments and following discussion.

### **§112 Rejection (Second paragraph)**

Claims 33, 35, 37, 42, 45, 50 and 53 have been rejected under 35 U.S.C. §112, 2<sup>nd</sup>, paragraph as being indefinite. In particular, claims 35, 37, 45 and 53 have been rejected on the grounds that certain terms lack antecedent basis, and claims 33, 42 and 50 have been rejected on the grounds that it is unclear whether 'a second indication' refers to 'a second user request'.

Claims 35, 37, 45 and 53 have been amended to provide antecedent basis for the terms 'currently executing program', 'context packet control' and to change the term 'context packets' to 'first context packet', for which there is antecedent basis. In addition, claims 33, 42 and 50 have been amended to recite a 'second user request' as suggested by the examiner.

The issues brought forward by the examiner having been addressed, withdrawal of the rejection of claims 33, 35, 37, 42, 45, 50 and 53 under 35 U.S.C. §112, 2<sup>nd</sup>, paragraph is respectfully requested.

### **§103 Rejections**

#### **Governing Legal Principles**

For rejections under 35 U.S.C. Section 103, the establishment of a *prima facie* case of obviousness requires that all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03. Additionally, to resolve the issue of patentability based on obviousness, the Examiner must not only look to the teaching in the asserted references that meets the claimed limitations, but must also point to the motivation in the asserted references that invites a combination in the event one reference is devoid of a particular teaching. Simply using the benefit of hindsight in combining references is improper, so that the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from

the cited prior art references for combination in the manner claimed. *See In re Lee*, 277 F.3d 1338, 1342-45 (Fed. Cir. 2002).

Furthermore, if a proposed modification would render the prior art invention being modified unsatisfactory for its intended purposes, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Additionally, if the proposed modification of the prior art would change the principle operation of the prior art invention being modified, then the teaching of the reference is not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

#### Discussion

a) Claims 29, 30, 32-35, 38, 39, 41-43, 46, 47 and 49-51 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,796,397 to Kusano ('*Kusano*') in view of U.S. Patent No. 6,757,365 to Bogard ('*Bogard*').

Independent claim 29 recites, *inter alia*, the feature of storing a program state associated with a display status when the first user request was received of the first program into a first context packet. While the examiner acknowledges that the primary *Kusano* reference lacks any disclosure or suggestion of this feature, it is asserted that the secondary *Bogard* reference does teach this feature. Applicants respectfully disagree with this assertion.

The section of *Bogard* which the examiner sites (and all related sections) merely state that "mechanisms for switching between running applications must be provided, this mechanism should allow preservation of state . . . when the user switches applications." *Bogard*, col. 6, lines 53-56. Conspicuously lacking in this statement (and other in the references) is any teaching or suggestion as to how the program state is to be preserved or what form such preservation might take. The stated terms "must be provided" and "should allow" further indicate that the *Bogard* inventors did not have a definite mechanism in mind for storing a program state. It is submitted that to argue that *Bogard* suggests (from these sections) storing program state in a context packet is in effect to read the terms "into a first context packet" out of claim 29 as if the claimed feature merely recited storing a program state without any provisions as to the storing mechanism. In sum, as neither *Kusano* nor *Bogard* teaches or suggests the use of context packets for storing a program state associated with a display status when a request is made to switch applications, it is submitted that the

references relied upon fail to render obvious the subject matter of independent claim 29 for this reason alone.

Moreover, it is submitted that the requisite motivation for combining the *Kusano* and *Bogard* references is lacking. While the examiner asserts those of skill in the art would have been motivated to combine the teachings of *Kusano* and *Bogard* on the grounds that “*Bogard* enhances the task switching capability of *Kusano* by providing the ability to switch between different programs and to return to the point where the user left off in the currently activated program,” *Kusano* provides its own mechanism for ensuring that a previously-activated program is restored, and thus a skilled practitioner, apprised of the teachings of *Kusano*, would not be motivated to consult the teachings of *Bogard*, particularly in light of their different principles of operation.

The *Kusano* reference apparently teaches a mechanism to transfer data between applications, for example, between a scheduling application and a task management application. As *Kusano* explains, data in fields that match between first and second applications is transferred when the first application calls the second application, while data in non-matching fields is not-transferred, but is stored in a discrete memory location specifically so that the data “can be re-used in the first application if selected later.” *Kusano*, col. 10, lines 26-28. Thus, the restoration provisions taught by *Kusano* are sufficient for the purposes discussed therein, and there would have been no need to consult the teachings of *Bogard* for the purpose of “enhancing task switching capability”, particularly in light of the fact that *Bogard* merely makes statements about preserving state information without providing any mechanisms as to how this is done, much less how it may be done in the context of the data transfer operations taught by *Kusano*.

For these additional reasons, it is submitted that a prima facie case of obviousness based on *Kusano* and *Bogard* has not been properly established with respect to claim 29, which is therefore patentable.

As claims 30 and 32-35 depend from claim 29, they are likewise patentable over the references relied upon.

As independent claims 38 and 46 recite subject matter analogous to that of claim 29, it is submitted that they are likewise patentable over the references relied upon as are their respective dependent claims 39, 41-43, 47 and 49-51.

Withdrawal of the rejection of claims 29, 30, 32-35, 38, 39, 41-43, 46, 47 and 49-51 under 35 U.S.C. § 103(a) is therefore respectfully requested.

b) Claims 31, 40 and 48 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Kusano* in view of *Bogard* in further view of U.S. Patent No. 5,675,762 to Bodin et al. ('*Bodin*').

It is initially noted that claims 31, 40 and 48 depend from independent claims 29, 38 and 46, respectively. Since the *Bodin* reference does not cure the deficiencies of the *Kusano* and *Bogard* references discussed above with respect to the context packet feature, it is submitted that claims 31, 40 and 48 are patentable over the references relied upon for this reason alone.

In addition, the motivation to combine the references relied upon is also insufficient to establish a prima facie case under §103. Claims 31 and 40, as amended, recite the feature of after suspending execution of the first program, releasing temporary memory used by the first program. Claim 48 recites an analogous feature. The examiner has cited the *Bodin* reference as teaching this feature and asserted that there would be motivation to combine the *Bodin* reference with the *Kusano* and *Bogard* reference because "Bodin's method of releasing memory of currently running program would improve the resource management and performance of *Kusano* and *Bogard*'s system be allowing re-use of memory once the program is suspended."

Applicants respectfully submit that the combination of *Bodin* with the other references is a hindsight reconstruction in light of the presently claimed invention. *Bodin* apparently teaches a system and method in which a peripheral device (XGA graphics adapter) is used. *Bodin* states that when a DOS XGA application (in a foreground) accesses the XGA hardware, all objects in a page table are locked down. *Bodin*, col. 6, lines 31-36. *Bodin* further states that "[l]ocked down memory is restored for system use when the DOS application is switched to background and no longer running . . . by unlocking and freeing all such memory" *Id.*, at lines 44-48. However, *Bodin* also explicitly states that the reason for freeing up the memory is that the microprocessor of the XGA device "requires the physical memory to be available for successful I/O transfers. Therefore, the risk of having the memories being swappable and not present should be avoided." *Id.*, at lines 40-43 (emphasis added). As can be discerned, the motivation for freeing memory taught by *Bodin* is to make sure a graphics card can handle I/O transfers. In other words, without freeing up the locked down memory, the graphics card may be unable to lock down the memory required for a foreground application.

A skilled practitioner consulting the *Kusano* and *Bogard* references would not be motivated to consult the *Bodin* reference to "improve resource management". *Bodin* is

concerned with the performance of a hardware device and concerns the nuts and bolts of memory allocation in a computer system. *Kusano* and *Bogard* are concerned with program applications for which the need to lock down or free up memory is not necessarily as vital as in the case of input/output from a hardware device. Put another way, there is no suggestion in either the *Kusano* or *Bogard* references of a possible lack of memory resources. To combine these references with a tertiary reference that is concerned with memory resource management is improper because the combination has been made simply in view of the fact that the claims 31, 40 and 38 do concern conserving memory resources. It is submitted that this combination represents the type of hindsight reconstruction that the case law and promulgated guidelines warn against.

For these additional reasons it is submitted that a *prima facie* case of obviousness based on *Kusano*, *Bogard* and *Bodin* has not been properly established with respect to claims 31, 40 and 48.

Withdrawal of the rejection of claims 31, 40 and 38 under 35 U.S.C. §103(a) is therefore respectfully requested.

Applicants wish point out in this regard by pointing that new independent claims 57 and 58 include the memory release feature recited in claims 31, 40 and 48.

c) Claims 37, 45 and 53-56 have been rejected under 35 U.S.C. §103(a) as being unpatentable over *Kusano* in view *Bogard* in further view of U.S. Patent No. 6,061,711 to Song et al. ('*Song*').

Claims 37, 45 and 53-56 each refer to a context packet control panel. Applicants' specification makes clear what this refers to where it states that "[o]ne alternate embodiment of the present invention includes a context packet control panel, providing a mechanism for a user to set parameters that affect context packages and to manage context packet memory usage." Applicants' specification, page 34, lines 12-14 (emphasis added). Neither the cited sections nor any other portion of the *Song* reference teach or suggest this feature. The context packet control panel is accessible by a user and not merely an application programmer by the presentation of a panel that allows users to make selections regarding attributes of the context packets. Moreover, the control that *Song* refers to is over the points at which a program may be halted for saving information and not over the memory or other parameters of context packets.

Accordingly, as the cited references do not teach or suggest all of the features of claims 37, 45 and 53-56, it is accordingly submitted that these claims are patentable over the references relied upon.

Withdrawal of the rejection of claims 37, 45 and 53-56 under 35 U.S.C. §103(a) is therefore respectfully requested.

#### **New Claims**

As alluded to above, new independent claims 57 and 58 recite the feature of releasing temporary memory used by the first program after suspending execution of the first program. It is submitted that this feature (among others, including context packets) is not taught or suggested by the cited references. The allowance of new claims 57 and 58 is therefore requested.

#### **CONCLUSION**

Having addressed all rejections and objections, Applicant respectfully submits that the subject application is in condition for allowance and a Notice to that effect is earnestly solicited. If necessary, the Commissioner for Patents is authorized to charge or credit the **Account No. 50-3102** for any deficiency or overpayment.

Respectfully submitted,

Date: December 26, 2007

Correspondence Address

**Cust. No. 49637**

Berry & Associates, P.C.  
9255 Sunset Boulevard, Suite 810  
Los Angeles, CA 90069  
Phone: (310) 247-2860  
Fax: (310) 247-2864

By: /Howard Grossman/

Reg. No. 48,673

Phone: 212-871-6266